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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,954	05/10/2006	Rolf Heggland	RR-615 PCT/US	8654
20427	7590	06/24/2009	EXAMINER	
RODMAN RODMAN 10 STEWART PLACE SUITE 2CE WHITE PLAINS, NY 10603			QUINN, COLLEEN M	
			ART UNIT	PAPER NUMBER
			3634	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,954	<b>Applicant(s)</b> HEGGLAND ET AL.	
	<b>Examiner</b> COLLEEN M. QUINN	<b>Art Unit</b> 3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/12/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3,5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 2: Regarding claim2, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Re claims 3 and 5: A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 3

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recites the broad recitation 10—40%, and the claim also recites preferably 20% which is the narrower statement of the range/limitation. Further, “preferably” makes it indefinite – is it preferred or required? Similar situation in claim 5 with respect to 1-5% and preferably 2%.

Also with respect to claim 3, proportion % with respect to what reference? The plastic material or the expansion material?

Also with respect to claim 5, is the weight with respect to the plastic?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Bothwell (US 6,431,316). Bothwell discloses a floor deck member (figure 1) for scaffolding (abstract), wherein the floor deck member at each end has a mounting area (figures 1 & 1A) designed to rest on a scaffold beam, wherein the floor deck member has a plurality of elongate reinforcing profiled members (36) which are embedded in longitudinal ribs (32, 34) on the underside of the floor deck member (figure 2), wherein between adjacent ribs there are arranged support ribs (30; figure 2); and wherein the deck member further comprises a walk surface (24); wherein the components of the deck member are made of a composite plastic material comprising a copolymer polypropylene with an added

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mineral material (col. 5, lines 59-67) and the deck member is characterized in that the respective end portions of said profiled members bear against opposing scaffold beams when the deck member is rested against a scaffolding beam, and that supporting pieces (18) are arranged at each end of the floor deck member and designed to limit movement of the floor deck members relative to opposing scaffold beams when said mounting areas are supporting the deck member via the mounting areas.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bothwell as applied to claim 1 above, and further in view of the MPEP.

Although Bothwell does not disclose the plastic material having an expansion material added to it during molding, Bothwell does disclose the final product to contain filler and expansion materials in addition to the plastic (col. 5, lines 59-67). The claim language directed to the addition of an expansion material during molding renders the claim a product by process claim, and MPEP 2113 Product-by-Process Claims explains that in a product claim, it is the end product that determines patentability, and not the product's method of production. In the instant case the prior art of Bothwell teaches the

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end product having filler/expansion materials, and whether such materials were added during molding or at another time or through another process is not patentably significant, only that the product is there in the end. Applicant should also see MPEP 2144.04 IV. *C. Changes in Sequence of Adding Ingredients* for further explanation as to the obvious of when ingredients are added.

Regarding claims 3 and 5 and their particular percentage requirements of each material, the examiner takes Official Notice that it would have been obvious to one of ordinary skill in the art to construct the deck member with whatever desired or necessary percentages of each material to achieve the desired strength and hardness for the particular application. At the time of the invention, one of ordinary skill in the art would have good reason to pursue the known options within his or her technical grasp, as the selected option was one of a finite number of available synthetic materials to mineral ratios. Such proportioned combinations of plastics, minerals and expansion materials, to one of ordinary skill in the art, would have a reasonable expectation of success, and would be based on ordinary skill and common sense at the time the invention was made.

Therefore, it would have been obvious to one of ordinary skill in the art to construct the deck member of Bothwell with whatever proportions of plastics, minerals and fillers necessary to achieve a deck member with desired or necessary strength and hardness for the instant application or job the deck member will be used for.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bothwell as applied to claims 1-3 and 5 above, and further in view of Sabel (US 4,272,211).

Bothwell does not disclose that the mineral material be dolomite.

However, Sabel teaches a wear resistant slab (1) for use as covering in areas exposed to excessive wear (abstract) wherein the slab material comprises a synthetic material mixed with filler minerals, such as dolomite, to provide an entirely consumable slab surface (col. 1, lines 42-46) that still provides a sufficiently suitable work surface capable of surviving exposure to harsh environments and consistent use.

Therefore, it would have been obvious to one of ordinary skill in the art to construct the deck member of Bothwell with a filler material such as dolomite as taught by Sabel, in order to provide a deck member with a sufficiently suitable work surface intended to survive exposure to harsh environments and consistent use as many scaffolding deck members are exposed on regular work sites.

Claims 6 & 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bothwell as applied to claim 1 above, and further in view of Misener (US 4,349,297). Bothwell fails to disclose the reinforcing members to extend from one floor deck member to another.

However, Misener teaches a floor deck member (16) for scaffolding (figure 1) wherein the floor deck members have longitudinally extending profiled reinforcement members (14) extending through longitudinal ribs (figures 1 & 2) on the bottom of the deck members wherein the longitudinally extending profiled reinforcement members are

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capable of being joined (figures 4 & 5) to the longitudinally extending profiled reinforcement members of an immediately adjacent floor deck (figures 4 & 5) and wherein the floor deck member can be split into numerous parts for insertion of one or more extension pieces (figure 1; any two adjacent deck members 16 can be separated and one or more additional deck member planks 16 can be inserted between the first two) wherein the profiled members can also be connected and extended to a desired length (figures 1, 2, 4 & 5).

Therefore, it would have been obvious to one of ordinary skill in the art to provide the scaffolding arrangement of Bothwell with the connectable profiled member arrangement and extension deck member planks as taught by Misener in order to provide a more easily extensible and collapsible scaffolding deck floor.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to COLLEEN M. QUINN whose telephone number is (571)272-6289. The examiner can normally be reached on 8:30AM-5:00PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on (571) 272-7069. The fax phone



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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KATHERINE W MITCHELL/  
Supervisory Patent Examiner, Art  
Unit 3634

/C. M. Q./  
Examiner, Art Unit 3634